

## **REMARKS**

### **Claim Status**

Applicants thank the Examiner, Mr. Phung-Hoang Nguyen, for the courtesies extended to applicants' representative during the Telephonic Interview conducted on September 21, 2010, and for his assistance in furthering prosecution on the merits of the instant application. During the Telephonic Interview, the subject matter of independent claims 1 and 9 was discussed. No agreement with respect to patentability of the claims was reached. The following remarks take into account the content of the telephone interview.

Applicants acknowledge, with appreciation, the indication that claims 5-6 and 8 contain allowable subject matter. Claims 1-17 are now pending, with claims 1 and 9 being in independent form. No amendments to the claims have been made. Reconsideration of the application is respectfully requested.

### **Overview of the Office Action**

Claims 1-4, 7 and 9-17 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,320,026 ("*Adamczyk*") in view of U.S. Pub. No. 2002/0076027 ("*Bernnan*").

Applicants have carefully considered the Examiner's rejections and the comments provided in support thereof. For the following reasons, applicants assert that all claims now pending in the present application are patentable over the cited art.

### **Patentability of the Independent Claims under 35 U.S.C. §103(a)**

The Examiner (at pg. 2 of the Final Office Action) has again acknowledged that *Adamczyk* fails to teach that "a prior test of the validity of the destination telephone number (NTEL) of the request (R) is executed automatically and locally to the requesting machine (H) relative to a

telephone number database (BD) local to the requesting machine (H) in order to forward the request (R) from the requesting machine (H) to the domain name server only if its destination telephone number (NTEL) passes said test” as recited in independent claim 1 and correspondingly recited in independent claim 9, and again cites *Bernman* for this feature.

Applicants, however, contend that no combination of *Adamczyk* and *Bernman* in fact achieves the subject matter of independent claims 1 and 9.

The Examiner (at pg. 8 of the Final Office Action; *Response to Arguments*) asserts that “Applicant appears to make argument against the references individually” and that “examiner has previously admitted that while *Adamczyk* does not specifically teach local database and validity test, however, *Bernman* teaches what is lacking in *Adamczyk*”. Applicants disagree. Applicants arguments apply to both documents in combination, i.e. the combination of *Adamczyk* and *Bernman* fails to teach or suggest a prior test of validity local to a requesting machine as currently claimed.

In a response filed March 24, 2010, applicants set forth the teachings of *Adamczyk* and explained that *Adamczyk* (col. 6, line 66 to col. 7, line 4) describes that “[p]latform 308 also has a DNS server communications module 316 that communicates with a DNS/ENUM server and database system 318. In an embodiment, such communications occur over the Internet 320, but it is not required. The DNS server system receives requests and queries from the DNS server communications module 316”. *Adamczyk* thus teaches that the user platform 308 sends one or more requests for subscriber address information to DNS server 318, where the request identifies a telephone number for the subscriber.

Moreover, applicants previously explained that based on the teachings of *Adamczyk*, the platform 308 of *Adamczyk* more aptly correlates to the requesting machine of independent claim 1, rather than the terminal 304 or 306 as asserted by the Examiner at pg 3, paragraph 4 of the Office

Action. For example, *Adamczyk* (col. 7, lines 52-57) explains that “[o]nce received, the platform 310 also has a subscriber communications module 330 for routing the message to the proper mailbox of the proper user, such as user 304 or user 306. Users 304 and/or 306 may then communicate with the platform 310 to retrieve any stored messages. With respect to user 306, such communication may occur via a PSTN 332 or some other communications network”. Accordingly, the devices designated by reference characters 304 and 306 do not receive requests and queries from the DNS server. Devices 304 and/or 306 merely communicate with the platform 310 to retrieve stored messages.

*Adamczyk* further explains that the user platform 308 sends requests to DNS 318 without regard to the validity, *vel non*, of the telephone numbers contained in these requests (see col. 7, lines 3-4). Thus, there is no test of validity prior to forwarding (or not forwarding) of the request to the DNS server. As recognized by the Examiner, *Adamczyk* explains that “DNS/ENUM server 318 may perform any number of internal lookup functions and/or external requests to locate the LDAP database 322 associated with the provided phone number” (col. 7, lines 10-13). Put another way, the system of *Adamczyk* contains the same, old and well-known disadvantages of DNS servers that are described at pg. 1, lines 23-34 of the instant specification as originally filed. That is, the DNS server 318 of *Adamczyk* is burdened with the task of processing all requests from platform 308, including erroneous or invalid requests for which no domain name exists, thereby significantly reducing the speed and rate at which valid requests are processed. In fact, the *Adamczyk* system processes and sends all requests to DNS server 318 irrespective of the validity of the telephone numbers contained in the requests. *Adamczyk* thus teaches away from performing the prior test of validity as required in claim 1, because there is no reason whatsoever in *Adamczyk* to perform such a prior validity test.

Given that *Adamczyk* fails to teach or suggest that a validity test is performed locally to the requesting machine and that the validity test is performed prior to deciding whether a request including the destination telephone number should be sent to the DNS, the Examiner seeks to cure this deficiency by citing *Bernnan*. The *Bernnan* system, however, fails to provide that which *Adamczyk* lacks. The skilled person is provided with no reason or motivation to consider the teachings of *Bernnan* to modify the *Adamczyk* method to achieve the method of independent claim 1, because there is no reason to perform a prior validity test in the *Adamczyk* system. That is, the combination of *Adamczyk* and *Bernnan* fails to achieve a system having a prior test of validity local to a requesting machine as expressly recited in claim 1.

According to the Examiner, the supervisory system (SS) 48 described at paragraph [0042] of *Bernnan* determines “the validity of the called number whether at least one communication address may include using information about the called party in a query to at least one database to obtain other information about the called party”. Under the Examiner proffered analysis, the SS 48 of *Bernnan* corresponds to the claimed requesting machine and the consultation step of database 50 of *Bernnan* corresponds to the claimed prior test of validity. Applicants disagree.

*Bernnan* (paragraph [0041]) explains that:

“If the call is not answered, ... the calling party’s supervisory system 48 will determine user information for the called party, including the called party’s address information and, if available, information regarding the called party’s communication devices’ 42 and their capability for sending and receiving various message types (S414).... (Emphasis added)

*Bernnan* thus teaches that the determination step performed by the SS 48 when consulting its database 50 merely allows the SS 48 to determine user information associated with the called party (i.e., associated with the called party’s telephone number), and suggests that it is possible to

determine whether this user information is available on database 50. Thus, the determination step described in *Bernnan* does not correspond to the claimed “test of validity of a destination telephone number” as recited in independent claim 1.

Moreover, even assuming *arguendo* that the SS 48 of *Bernnan* determines that no user information exists in the database 50 in association with the called party, this does not mean that the requested telephone number is invalid, but merely that no user information is recorded for the called party. Indeed, *Bernnan* teaches a system in which a telephone number with no associated user information recorded in database 50 can still be valid.

Furthermore, even if the determination step performed in *Bernnan* were to correspond to the claimed prior test of validity – which in any event applicants dispute – it is clear that this determination step is not used to determine whether the claimed request should be forwarded to a DNS server. According to the Examiner, *Bernnan* (paragraph [0044]) further explains that “[u]sing the available called party addresses that have been determined by one or more queries of one or more databases, the supervisory system 48 presents the available messaging options to allow the calling party to determine the type of message the calling party wishes to compose”(Emphasis added).

Thus, when the telephone number of the called party “passes” the determination step in *Bernnan*, the SS 48 merely presents available options to the calling party. *Bernnan*, however, fails to teach or suggest that a request containing an E.164 format destination telephone number is forwarded to a DNS server only if the determination step is successful in finding user information.

In fact, the skilled person can readily appreciate that the step of presenting available options in *Bernnan* occurs only after the SS 48 has attempted to establish a connection between the calling and called party. In contrast, the prior test of independent claim 1 is performed prior to forwarding a request to a DNS server.

The teachings of *Bernnan* have nothing whatsoever to do with a DNS server nor with an E.164.arpa telephone number domain name server. Instead, *Bernnan* merely seeks to provide a calling party with user information, which is substantially different from the object of applicants' claimed invention. As discussed during the telephonic interview and as explained at pg. 1, lines 23-34 and pg. 2, lines 17-24 of the application as originally filed, "name servers may receive many read and write requests including erroneous requests for which the name does not exist in the domain name servers" and "[b]y means of the invention, recourse to the domain name servers is limited and they are relieved of pointless processing. An erroneous request from a requesting machine is recognized as such, and prevented from reaching name servers, by determining that the destination telephone number of the request is invalid, for example by determining that it is impossible for that number to exist". There is nothing in *Adamczyk* and/or *Bernnan* to teach or suggest a method that addresses the problem of relieving a DNS server of pointless request processing, by preventing requests for unknown domain names from reaching this DNS server.

Moreover, were the skilled person to use the teachings of *Bernnan* to modify the method of *Adamczyk*, at best he would merely achieve a method in which options are presented to a user on the device 302 of *Adamczyk* when no direct communication can be established between devices 302 and 304/306 and when user information can be retrieved from a database by platform 308 of *Adamczyk*.

Lastly, the Examiner (at pg. 9) reiterates his assertion that "the validity of a call processing test is a function of digit analysis" and that "every single digit entered, will be run through a database and verify the authenticity of the destination prior to establishment". In addition, the Examiner asserts that "the process of validity test is a pre-requisite [to] steps of any communication establishment". Indeed, there is no disputing that it is generally known to perform a "test" prior to establishing a communication to verify whether the communication can be

established between a calling party and a called party. As articulated by the Examiner, the SIP protocol requires sending an INVITE message and receiving in response an ACK message prior to establishing a communication between two parties. However, this alleged “test” does not correspond to applicants’ claimed prior test of validity. More specifically, the Examiner proffered test performed in accordance with the SIP protocol is not used to determine whether a request containing an E.164 format destination telephone number should be forwarded from a requested machine to a DNS server, as defined by independent claim 1. At best, the Examiner proffered test is used to determine whether to establish a communication between the calling party and called party, which is inherently different from what applicants have disclosed and claimed. As explained previously, *Adamczyk* and/or *Bernnan* do not seek to relieve a DNS server from pointless request processing. Independent claim 1 is therefore deemed to be patentable over the combination of *Adamczyk* and *Bernnan*, because – even assuming the propriety of the combination – *Bernnan* fails to provide that which *Adamczyk* lacks.

Independent claim 9 recites limitations similar to those of independent claim 1 and is, therefore, deemed to be patentably distinct over the combination of *Adamczyk* and *Bernnan* for *at least* those reasons discussed above with respect to independent claim 1.

By virtue of the above-discussed differences between the recitations of independent claims 1 and 9 and the teachings of *Adamczyk* in combination with *Bernnan*, and the lack of any clear motivation for modifying the reference teachings to achieve applicants’ claimed invention, independent claims 1 and 9 are deemed to be patentable over the combination of *Adamczyk* and *Bernnan* under 35 U.S.C. §103.

### **Dependent Claims**

In view of the patentability of independent claims 1 and 9 for the reasons presented above, each of dependent claims 2-8 and 10-17 is respectfully deemed to be patentable therewith over the prior art. Moreover, each of these claims includes features which serve to still further distinguish the claimed invention over the applied art.

### **Conclusion**

Based on all of the above, applicants submit that the present application is now in full and proper condition for allowance. Prompt and favorable action to this effect, and early passage of the application to issue, are once more solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned to facilitate an early resolution of any outstanding issues.

Respectfully submitted,  
COHEN PONTANI LIEBERMAN & PAVANE LLP

By /Alfred W. Froebrich/  
Alfred W. Froebrich  
Reg. No. 38,887  
551 Fifth Avenue, Suite 1210  
New York, New York 10176  
(212) 687-2770

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